



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: Savage et al.  
Application No. 09/181, 658  
Filed: October 29, 1998  
For: **A METHOD AND SYSTEM OF COMBINED  
BILLING OF MULTIPLE ACCOUNTS ON A  
SINGLE STATEMENT**  
  
Examiner: Harbeck, Timothy M.  
Group Art Unit: 3628

**APPEAL BRIEF**

Mail Stop Appeal Brief-Patents  
Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

10/31/2006 HDEMESS1 00000076 09181658  
01 FC:1402 500.00 OP

Sir:

This is an Appeal Brief under 37 C.F.R. § 41.37 in connection with the decision of the Examiner mailed on February 3, 2006. A Notice of Appeal with a two-month extension of time was filed on June 30, 2006 setting the time for filing an Appeal Brief to expire on August 30, 2006. A two-month extension of time is being submitted herewith to extend the period for filing the Appeal Brief up to and including October 30, 2006.

This Appeal Brief fully complies with all provisions of 37 CFR 41.37(c) and each of the topics required by § 41.37 is presented herewith and is labeled appropriately. It is not believed that any additional fees are due, but if so, please charge any deficiency to Deposit Account No. 50-1458.

**(1) Real Party In Interest**

The real party in interest is Universal Card Services Corp.

**(2) Related Appeals And Interferences**

Appeal No. 2004-0094 was an appeal by applicants herein from a prior decision of the Examiner in this application rejecting claims 1, 4-6, and 9-57 in a final office action

mailed January 15, 2002, in which the Board issued its Decision on Appeal on September 23, 2004 refusing to sustain the Examiner's rejection of any of the rejected claims.

Except as noted above, there are no other appeals or interferences related to this case.

**(3) Status of Claims**

Claims 1, 4-6 and 9-57 are pending and all have been rejected.

Claims 2, 3, 7, and 8 have been canceled.

No claims have been allowed.

No claims have been withdrawn.

Claims 1, 4-6 and 9-57 are hereby appealed.

**(4) Status of Amendments**

There are no amendments after final rejection.

**(5) Summary of Claimed Subject Matter**

Independent claim 1 proposes a method of combined billing for at least one customer on a plurality of customer accounts that includes, for example, receiving account data for the plurality of customer accounts electronically from time-to-time by a service provider from each of a plurality of billers (See, e.g., Specification, p. 6, lines 5-7, lines 9-15, and lines 26-27; p. 10, lines 17-25; p. 18, lines 3-7; and Figs. 1-3); acquiring ownership of receivables represented by the account data by the service provider under contractual arrangements with the plurality of billers upon receipt of the account data (See, e.g., Specification, p. 5, lines 22-27; p. 7, lines 7-15; and Figs. 1-3); automatically calculating account charges for the plurality of customer accounts from the account data (See, e.g., Specification, p. 6, lines 15-20; p. 10, line 28 -p. 11, line 3; p. 11, lines 11-13; p. 15, lines 18-23; p. 37, line 28-p. 41, line 24; and Figs. 1-3 and 20); aggregating the account charges for at least one customer on the plurality of customer accounts (See, e.g., Specification, p. 10, lines 11-20 and lines 27-28; p. 11, lines 9-13 and lines 28-29; p. 15, lines 23-27; p. 18, lines 7-13; p. 41, line 25-p. 45, line

3; and Figs. 1-3 and 21); automatically formatting a combined bill for the customer from the aggregated account charges (See, e.g., Specification, p. 10, lines 12-14 and 26-26; p. 11, lines 14-15 and lines 29-30; p. 45, line 23-p. 46, line 10; and Figs. 1-3 and 22); and automatically rendering the combined bill to the customer (See, e.g., Specification, p. 10, lines 14-15; p. 11, lines 15-27; p. 11, line 30-p. 12, line 2; p. 15, lines 27-29; p. 18, lines 18-21; p. 46, lines 10-24; and Figs. 1-3 and 22-29). Independent claim 1 further proposes that at least one of the plurality of accounts is a recurring bill account and wherein the customer continues to purchase products or services from at least one of the billers after the service provider acquires ownership of the receivables associated with the account data received (See, e.g., Specification, p. 6, lines 1-25 and Figs. 1-3).

Independent claim 50 proposes a system for combined billing for at least one customer on a plurality of customer accounts that involves, for example, means for receiving account data for the plurality of customer accounts electronically from time-to-time by a service provider from each of a plurality of billers (See, e.g., Specification, p. 6, lines 5-7, lines 9-15, and lines 26-27; p. 10, lines 17-25; p. 18, lines 3-7; and Figs. 1-3); means for acquiring ownership of receivables represented by the account data by the service provider under contractual arrangements with the plurality of billers upon receipt of the account data (See, e.g., Specification, p. 5, lines 22-27; p. 7, lines 7-15; and Figs. 1-3); means for automatically calculating account charges for the plurality of customer accounts from the account data (See, e.g., Specification, p. 6, lines 15-20; p. 10, line 28 -p. 11, line 3; p. 11, lines 11-13; p. 15, lines 18-23; p. 37, line 28-p. 41, line 24; and Figs. 1-3 and 20); means for aggregating the account charges for at least one customer on the plurality of customer accounts (See, e.g., Specification, p. 10, lines 11-20 and lines 27-28; p. 11, lines 9-13 and lines 28-29; p. 15, lines 23-27; p. 18, lines 7-13; p. 41, line 25-p. 45, line 3; and Figs. 1-3 and 21); means coupled to the aggregating means for automatically formatting a combined bill for the customer from the aggregated account charges (See, e.g., Specification, p. 10, lines 12-14 and 26-26; p. 11, lines 14-15 and lines 29-30; p. 45, line 23-p. 46, line 10; and Figs. 1-3 and 22); and means associated with the formatting means for automatically rendering the combined bill to the customer (See, e.g., Specification, p. 10, lines 14-15; p. 11, lines 15-27;

p. 11, line 30-p. 12, line 2; p. 15, lines 27-29; p. 18, lines 18-21; p. 46, lines 10-24; and Figs. 1-3 and 22-29). Independent claim 50 further proposes that at least one of the plurality of accounts is a recurring bill account and wherein the customer continues to purchase products or services from at least one of the billers after the service provider acquires ownership of the receivables associated with the account data received (See, e.g., Specification, p. 6, lines 1-25 and Figs. 1-3).

Independent claim 54 proposes a method of combined billing for at least one customer on a plurality of customer accounts by a service provider involving, for example, entering contractual arrangements with a plurality of billers to have their account data for the plurality of customer accounts delivered to a service provider electronically (See, e.g., Specification, p. 5, lines 28-30 and Figs. 1-3); receiving the account data electronically from time-to-time during a billing cycle by the service provider from each of the billers, each reading out transactions one at a time to an accounts receivable computer system of the service provider (See, e.g., Specification, p. p. 6, lines 9-12; p. 18, lines 3-6; and Figs. 1-3); storing the account data at a customer level in a computer database of the service provider (See, e.g., Specification, p. 5, line 30-p. 6, line 1 and Figs. 1-3); acquiring ownership by the service provider of receivables represented by the account data under the contractual arrangement when the account data is received by the service provider (See, e.g., Specification, p.5, lines 22-27; p. 7, lines 7-15; and Figs. 1-3); remitting payment for the receivables to the billers by the service provider under the contractual arrangement within a pre-determined period after receiving the account data (See, e.g., Specification, p. 7, lines 7-15 and Figs. 1-3); automatically calculating account charges for the plurality of customer accounts from the account data (See, e.g., Specification, p. 6, lines 15-20; p. 10, lines 15-17; p. 10, line 28-p. 11, line 3; p. 11, lines 11-13; p. 15, lines 18-23; p. 37, line 28-p. 41, line 24; and Figs. 1-3 and 20); aggregating account charges for at least one customer on a plurality of customer accounts (See, e.g., Specification, p. 10, lines 11-12 and lines 27-28; p. 11, lines 9-13 and lines 28-29; p. 15, lines 23-27; p. 18, lines 7-13; p. 41, line 25-p. 45, line 3; and Figs. 1-3 and 21); automatically generating a combined bill for the customer from the aggregated account charges at a pre-determined cycle time for the customer's account (See, e.g.,

Specification, p. 10, lines 12-14 and lines 26-27; p. 11, lines 14-15 and lines 29-30; p. 45, line 23-p. 46, line 10; and Figs. 1-3 and 22); and automatically rendering the combined bill to the customer as a debt of the customer to the service provider as owner of the receivable represented by the combined bill (See, e.g., Specification, p. 6, lines 1-5 and lines 20-25; p. 10, lines 14-15; p. 11, lines 15-27; p. 11, line 30-p. 12, line 2; p. 15, lines 27-29; p. 18, lines 18-21; p. 46, lines 10-24; and Figs. 1-3 and 22-29). Independent claim 54 further proposes that at least one of the plurality of accounts is a recurring bill account and wherein the customer continues to purchase products or services from at least one of the billers after the service provider acquires ownership of the receivables associated with the account data received (See, e.g., Specification, p. 6, lines 1-25 and Figs. 1-3).

Independent claim 55 proposes a system of combined billing for at least one customer on a plurality of customer accounts by a service provider that involves, for example, means for entering contractual arrangements with a plurality of billers to have their account data for the plurality of customer accounts delivered to a service provider electronically (See, e.g., Specification, p. 5, lines 28-30 and Figs. 1-3); means for receiving the account data electronically from time-to-time during a billing cycle by the service provider from each of the billers, each reading out transactions one at a time to an accounts receivable computer system of the service provider (See, e.g., Specification, p. p. 6, lines 9-12; p. 18, lines 3-6; and Figs. 1-3); means for storing the account data at a customer level in a computer database of the service provider (See, e.g., Specification, p. 5, line 30-p. 6, line 1 and Figs. 1-3); means for acquiring ownership by the service provider of receivables represented by the account data under the contractual arrangement when the account data is received by the service provider (See, e.g., Specification, p.5, lines 22-27; p. 7, lines 7-15; and Figs. 1-3); means for remitting payment for the receivables to the billers by the service provider under the contractual arrangement within a pre-determined period after receiving the account data (See, e.g., Specification, p. 7, lines 7-15 and Figs. 1-3); means for automatically calculating account charges for the plurality of customer accounts from the account data (See, e.g., Specification, p. 6, lines 15-20; p. 10, lines 15-17; p. 10, line 28-p. 11, line 3; p. 11, lines 11-13; p. 15, lines 18-23; p. 37, line 28-p. 41, line 24; and Figs. 1-3 and 20); means for

aggregating account charges for at least one customer on a plurality of customer accounts (See, e.g., Specification, p. 10, lines 11-12 and lines 27-28; p. 11, lines 9-13 and lines 28-29; p. 15, lines 23-27; p. 18, lines 7-13; p. 41, line 25-p. 45, line 3; and Figs. 1-3 and 21); means for automatically formatting a combined bill for the customer from the aggregated account charges (See, e.g., Specification, p. 10, lines 12-14 and 26-26; p. 11, lines 14-15 and lines 29-30; p. 45, line 23-p. 46, line 10; and Figs. 1-3 and 22); means for automatically generating a combined bill for the customer from the aggregated account charges at a pre-determined cycle time for the customer's account (See, e.g., Specification, p. 10, lines 12-14 and lines 26-27; p. 11, lines 14-15 and lines 29-30; p. 45, line 23-p. 46, line 10; and Figs. 1-3 and 22); and means for automatically rendering the combined bill to the customer as a debt of the customer to the service provider as owner of the receivable represented by the combined bill (See, e.g., Specification, p. 6, lines 1-5 and lines 20-25; p. 10, lines 14-15; p. 11, lines 15-27; p. 11, line 30-p. 12, line 2; p. 15, lines 27-29; p. 18, lines 18-21; p. 46, lines 10-24; and Figs. 1-3 and 22-29). Independent claim 55 further proposes that at least one of the plurality of accounts is a recurring bill account and wherein the customer continues to purchase products or services from at least one of the billers after the service provider acquires ownership of the receivables associated with the account data received (See, e.g., Specification, p. 6, lines 1-25 and Figs. 1-3).

Independent claim 56 proposes a method of combined billing for at least one customer on a plurality of customer accounts by a financial institution that includes, for example, entering contractual arrangements with a plurality of billers to have their account data for the plurality of customer accounts delivered to a financial institution electronically (See, e.g., Specification, p. 5, lines 28-30 and Figs. 1-3); periodically receiving the account data electronically during a billing cycle by the financial institution from each of the billers, each reading out transactions one at a time to an accounts receivable computer system of the financial institution (See, e.g., Specification, p. 6, lines 9-12; p. 18, lines 3-7; and Figs. 1-3); storing the account data at a customer level in a computer database of the financial institution (See, e.g., Specification, p. 5, line 30-p. 6, line 1 and Figs. 1-3); acquiring ownership by the financial institution of receivables represented by the account data under the contractual

arrangement when the account data is periodically received by the financial institution (See, e.g., Specification, p. 5, lines 22-27; p. 7, lines 7-15; and Figs. 1-3); remitting payment for the receivables to the billers by the financial institution under the contractual arrangement within a pre-determined period after receiving the account data (See, e.g., Specification, p. 7, lines 7-15 and Figs. 1-3); automatically calculating account charges for the plurality of customer accounts from the account data (See, e.g., Specification, p. 6, lines 15-20; p. 10, lines 15-17; p. 10, line 28-p. 11, line 3; p. 11, lines 11-13; p. 15, lines 18-23; p. 37, line 28-p. 41, line 24; and Figs. 1-3 and 20); aggregating account charges for at least one customer on a plurality of customer accounts (See, e.g., Specification, p. 10, lines 11-12 and lines 27-28; p. 11, lines 9-13 and lines 28-29; p. 15, lines 23-27; p. 18, lines 7-13; p. 41, line 25-p. 45, line 3; and Figs. 1-3 and 21); automatically generating a combined bill for the customer from the aggregated account charges at a pre-determined cycle time for the customer's account (See, e.g., Specification, p. 10, lines 12-14 and lines 26-27; p. 11, lines 14-15 and lines 29-30; p. 45, line 23-p. 46, line 10; and Figs. 1-3 and 22); and automatically rendering the combined bill to the customer as a debt of the customer to the service provider as owner of the receivable represented by the combined bill (See, e.g., Specification, p. 6, lines 1-5 and lines 20-25; p. 10, lines 14-15; p. 11, lines 15-27; p. 11, line 30-p. 12, line 2; p. 15, lines 27-29; p. 18, lines 18-21; p. 46, lines 10-24; and Figs. 1-3 and 22-29). Independent claim 56 further proposes that at least one of the plurality of accounts is a recurring bill account and wherein the customer continues to purchase products or services from at least one of the billers after the service provider acquires ownership of the receivables associated with the account data received (See, e.g., Specification, p. 6, lines 1-25 and Figs. 1-3).

Independent claim 57 proposes a system of combined billing for at least one customer on a plurality of customer accounts by a service provider involving, for example, means for entering contractual arrangements with a plurality of billers to have their account data for the plurality of customer accounts delivered to a financial institution electronically (See, e.g., Specification, p. 5, lines 28-30 and Figs. 1-3); means for periodically receiving the account data electronically during a billing cycle by the financial institution from each of the billers, each reading out transactions one at a time to an accounts receivable computer system of the

financial institution (See, e.g., Specification, p. 6, lines 9-12; p. 18, lines 3-7; and Figs. 1-3); means for storing the account data at a customer level in a computer database of the financial institution (See, e.g., Specification, p. 5, line 30-p. 6, line 1 and Figs. 1-3); means for acquiring ownership by the financial institution of receivables represented by the account data under the contractual arrangement when the account data is periodically received by the financial institution (See, e.g., Specification, p. 5, lines 22-27; p. 7, lines 7-15; and Figs. 1-3); means for remitting payment for the receivables to the billers by the financial institution under the contractual arrangement within a pre-determined period after receiving the account data (See, e.g., Specification, p. 7, lines 7-15 and Figs. 1-3); means for automatically calculating account charges for the plurality of customer accounts from the account data (See, e.g., Specification, p. 6, lines 15-20; p. 10, lines 15-17; p. 10, line 28-p. 11, line 3; p. 11, lines 11-13; p. 15, lines 18-23; p. 37, line 28-p. 41, line 24; and Figs. 1-3 and 20); means for aggregating account charges for at least one customer on a plurality of customer accounts (See, e.g., Specification, p. 10, lines 11-12 and lines 27-28; p. 11, lines 9-13 and lines 28-29; p. 15, lines 23-27; p. 18, lines 7-13; p. 41, line 25-p. 45, line 3; and Figs. 1-3 and 21); means for automatically generating a combined bill for the customer from the aggregated account charges at a pre-determined cycle time for the customer's account (See, e.g., Specification, p. 10, lines 12-14 and lines 26-27; p. 11, lines 14-15 and lines 29-30; p. 45, line 23-p. 46, line 10; and Figs. 1-3 and 22); means for automatically formatting a combined bill for the customer from the aggregated account charges (See, e.g., Specification, p. 10, lines 12-14 and 26-26; p. 11, lines 14-15 and lines 29-30; p. 45, line 23-p. 46, line 10; and Figs. 1-3 and 22); and means for automatically rendering the combined bill to the customer as a debt of the customer to the service provider as owner of the receivable represented by the combined bill (See, e.g., Specification, p. 6, lines 1-5 and lines 20-25; p. 10, lines 14-15; p. 11, lines 15-27; p. 11, line 30-p. 12, line 2; p. 15, lines 27-29; p. 18, lines 18-21; p. 46, lines 10-24; and Figs. 1-3 and 22-29). Independent claim 57 further proposes that at least one of the plurality of accounts is a recurring bill account and wherein the customer continues to purchase products or services from at least one of the billers after the service provider acquires ownership of the receivables associated with the account data received (See, e.g., Specification, p. 6, lines 1-25 and Figs. 1-3).



**(6) Grounds of Rejection to be Reviewed on Appeal**

Claims 1, 4, 9-16, 38-41, and 50-57 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Saville (“Defining: CONVERGENT BILLING & CUSTOMER CARE,” A Telecommunications Industry White Paper, Spring 1997) in view of Steven Martin “CHECKFREE-INTEGRION TEAM TO ABSORB VISA’S ePay”, Bank Technology News. New York: Aug. 1998. Vol 35, Iss.8; p 22 (page 1).

Claims 5 and 6 rejected under 35 U.S.C. 103(a) as being unpatentable over Saville in view of Martin and further in view of: “ECTC ENTERS WHOLESALE BILL PRESENTMENT ARENA”, Retail Delivery News. Potomac: Oct 28, 1998 Vol. 3, iss 21; p. 1.

Claims 17-37 and 42-49 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Saville and Martin and further in view of Smorodinsky (US PAT 6,049,786).

**(7) Argument**

**The Rejection of Claims 1, 4, 9-16, 38-41, and 50-57 under 35 U.S.C. 103(a) as being unpatentable over Saville (“Defining: CONVERGENT BILLING & CUSTOMER CARE,” A Telecommunications Industry White Paper, Spring 1997) in view of Steven Martin “CHECKFREE-INTEGRION TEAM TO ABSORB VISA’S ePay”, Bank Technology News. New York: Aug. 1998. Vol 35, Iss.8; p 22 (page 1) is Improper**

With regard to independent claims 1, 50, and 54-57, the Examiner considers that Saville discloses each and every element of each of claims 1, 50, and 54-57 except acquiring ownership by the financial institution of receivables represented by the account data under the contractual arrangement when the account data is periodically received by the financial institution, as recited in each of claims 1, 50, and 54-57, which the Examiner considers to be taught by Steven Martin.

On the contrary, there is no motivation to modify Saville in view of Martin , and the proposed modification lacks one or more limitations recited in each of independent claims 1, 50, and 54-57 in at least the following respects:

- Saville fails to teach or suggest receiving account data electronically from time-to-time from billers and acquiring ownership of the receivables associated with the account data upon receipt of the account data from the billers and wherein at least one of the accounts is a recurring bill account as claimed in independent claims 1, 50, and 54-57. On the contrary, according to the Examiner, Saville teaches “the benefits of convergent billing—a single consolidated bill” “for combined power, light and telephone services” “to make the customer the one liable for the receivables (or debt) directly to each of the billers”. See, e.g., Office Action mailed 5/26/05, p. 2, line 22-p. 3, line 23.
- The Examiner’s broad conclusory statement that “It is obvious that the billers [in Saville] would have viewed it as a positive thing for them to quickly transfer ownership of the receivables (or debt) to the Service Provider and let them be the one who collects from the customer over time” is unsupported by anything in Saville and is, in fact, directly contradicted by the Examiner’s further statement that “The Saville system instead was silent with regards to this feature [i.e., “acquiring ownership of receivables represented by the account data by the service provider under contractual arrangements with the plurality of billers upon receipt of the account data.”] See, e.g., Office Action mailed 5/26/05, p. 3, line 18-p. 4, line 6.
- Martin is likewise devoid of any teaching or suggestion of receiving account data electronically from time-to-time from billers and acquiring ownership of the receivables associated with the account data upon receipt of the account data from the billers and wherein at least one of the accounts is a recurring bill account as claimed in independent claims 1, 50, and 54-57. Instead, Martin announces CheckFree’s use of VISA’s ePay electronic bill payment feature with “direct debit and settlement features” that allows consumers “to order the payment today and, when they look at their account tomorrow, it’s paid”. See, e.g., Martin, 2<sup>nd</sup> Column, lines 3-9. Moreover, according to Ceme, “Checkfree, VISA Launch Payment Service” cited but not applied by the Examiner, VISA’s ePay debit and settlement feature simply “offers the ability to electronically debit money from a customer’s account and pass it on to a biller’s bank.” Thus, it is readily apparent that Martin merely teaches the, by now,

well known debit card system in which the customer's account is debited during a transaction before authorizing the transaction with a merchant.

- Further, the Examiner's statement that "it would have been obvious...to modify the Seville [sic] method to perform the additional step of; 'acquiring ownership of receivables represented by the account data by the service provider under contractual arrangements with the plurality of billers upon receipt of the account data' as taught by Steven Martin because to do so would have quickly freed up working capital and would have helped billers with their cash flow" completely mischaracterizes the teaching of Martin, for example, in that there is no receivable to acquire in Martin. On the contrary, according to Martin, the "guaranteed good funds" come from debiting the customer's account direct and electronically sending the debited funds to the biller's bank in what is, in fact, a cash transaction.

Consequently, Saville and/or Martin, either separately or in combination with one another, do not recite the required combination of limitations of amended independent claims 1, 50, and 54-57, that propose, e.g., receiving account data electronically from time-to-time from billers and acquiring ownership of the receivables associated with the account data upon receipt of the account data from the billers and wherein at least one of the accounts is a recurring bill account.

Because Saville and/or Martin, either alone or in combination with one another, do not teach the limitations of independent claims 1, 50, and 54-57, the Examiner has failed to establish the required *prima facie* case of unpatentability. See, In re Royka, 490 F.2d 981, 985 (C.C.P.A., 1974) (holding that a *prima facie* case of obviousness requires the references to teach all of the limitations of the rejected claim); See also MPEP §2143.03. Similarly, the Examiner has failed to establish a *prima facie* case of unpatentability for claims 4-6 and 9-49 that depend on claim 1 and claims 51-53 that depend on claim 50 and which recite further specific elements that have no reasonable correspondence with the references.

**The Rejection of Claims 5 and 6 under 35 U.S.C. 103(a) as being unpatentable over Saville in view of Martin and further in view of: "ECTC ENTERS WHOLESALE BILL PRESENTMENT ARENA", Retail Delivery News. Potomac: Oct 28, 1998 Vol. 3, iss 21; p. 1. is Improper**

As noted above, because Saville and/or Steven Martin, either alone or in combination with one another, do not teach the limitations of independent claims 1, 50, and 54-57, the Examiner has failed to establish the required *prima facie* case of unpatentability of independent claims 1, 50, and 54-57, and similarly has failed to establish a *prima facie* case of unpatentability of claims 5 and 6 that depend on claim 1 and which recite further specific elements that have no reasonable correspondence to the references.

ECTC fails to remedy the deficiencies of Saville and Steven Martin. On the contrary, ETCT is devoid of any teaching or suggestion of receiving account data electronically from time-to-time from billers and acquiring ownership of the receivables associated with the account data upon receipt of the account data from the billers and wherein at least one of the accounts is a recurring bill account as claimed in independent claims 1, 50, and 54-57. Instead, ECTC merely announces a proposal to develop an electronic payments system six months in the future that has nothing to do with acquiring receivables, but likewise proposes "guaranteed funds" using "a real-time payment system", i.e., a cash transaction.

Consequently, Saville, Martin, and/or ECTC, either separately or in combination with one another, do not recite the required combination of limitations of amended independent claims 1, 50, and 54-57, that propose, e.g., receiving account data electronically from time-to-time from billers and acquiring ownership of the receivables associated with the account data upon receipt of the account data from the billers and wherein at least one of the accounts is a recurring bill account.

Because Saville, Martin, and/or ECTC, either alone or in combination with one another, do not teach the limitations of independent claims 1, 50, and 54-57, the Examiner has failed to establish the required *prima facie* case of unpatentability. See, In re Royka, 490 F.2d 981, 985 (C.C.P.A., 1974) (holding that a *prima facie* case of obviousness requires the references to teach all of the limitations of the rejected claim); See also MPEP §2143.03.

Similarly, the Examiner has failed to establish a *prima facie* case of unpatentability for claims 5 and 6 that depend on claim 1 and which recite further specific elements that have no reasonable correspondence with the references.

**The Rejection of Claims 17-37 and 42-49 under 35 U.S.C. 103(a) as being unpatentable over Saville and Martin and further in view of Smorodinsky (US PAT 6,049,786) is Improper**

Likewise as noted above, because Saville and/or Steven Martin, either alone or in combination with one another, do not teach the limitations of independent claims 1, 50, and 54-57, the Examiner has failed to establish the require *prima facie* case of unpatentability of independent claims 1, 50, and 54-57, and similarly has failed to establish a *prima facie* case of unpatentability of claims 17-37 and 42-49 that depend on claim 1 and which recite further specific elements that have no reasonable correspondence to the references.

Smorodinsky likewise fails to remedy the deficiencies of Saville and Steven Martin. On the contrary, Smorodinsky does not teach or suggest receiving account data electronically from time-to-time from billers and acquiring ownership of the receivables associated with the account data upon receipt of the account data from the billers and wherein at least one of the accounts is a recurring bill account as claimed in independent claims 1, 50, and 54-57. On the contrary, Smorodinsky focuses on an electronic bill presentment and payment system that employs hashes and digital signatures to avoid cheating by billers and/or customers, and which has nothing to do with combined billing or acquiring ownership of receivables associated with the account data upon receipt of account data electronically from the billers. See, e.g., Smorodinsky, Col. 4, lines 1-52.

Consequently, Saville, Martin, and/or Smorodinsky, either separately or in combination with one another, do not recite the required combination of limitations of amended independent claims 1, 50, and 54-57, that propose, e.g., receiving account data electronically from time-to-time from billers and acquiring ownership of the receivables associated with the account data upon receipt of the account data from the billers and wherein at least one of the accounts is a recurring bill account.

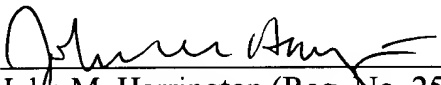
Because Saville, Martin, and/or Smorodinsky, either alone or in combination with one another, do not teach the limitations of independent claims 1, 50, and 54-57, the Examiner has failed to establish the required *prima facie* case of unpatentability. See, In re Royka, 490 F.2d 981, 985 (C.C.P.A., 1974) (holding that a *prima facie* case of obviousness requires the references to teach all of the limitations of the rejected claim); See also MPEP §2143.03. Similarly, the Examiner has failed to establish a *prima facie* case of unpatentability for claims 17-37 and 42-49 that depend on claim 1 and which recite further specific elements that have no reasonable correspondence with the references.

**(9) Conclusion**

For at least the reasons given above, the rejection of claims 1, 4-6 and 9-57 is improper. Applicant respectfully requests the final rejection by the Examiner be reversed and claims 1, 4-6 and 9-57 be allowed. Attached below is an Appendix of claims 1, 4-6 and 9-57 for ease of reference.

Respectfully submitted,

Date: 10/30/06

By:   
John M. Harrington (Reg. No. 25,592)  
For George T. Marcou (Reg. No. 33,014)

KILPATRICK STOCKTON LLP  
607 14<sup>th</sup> Street, NW, Suite 900  
Washington, DC 20005  
(202) 508-5800

**(8) Claims Appendix**

1. A method of combined billing for at least one customer on a plurality of customer accounts, comprising:
  - receiving account data for the plurality of customer accounts electronically from time-to-time by a service provider from each of a plurality of billers;
  - acquiring ownership of receivables represented by the account data by the service provider under contractual arrangements with the plurality of billers upon receipt of the account data;
  - automatically calculating account charges for the plurality of customer accounts from the account data;
  - aggregating the account charges for at least one customer on the plurality of customer accounts;
  - automatically formatting a combined bill for the customer from the aggregated account charges; and
  - automatically rendering the combined bill to the customer;wherein at least one of the plurality of accounts is a recurring bill account and wherein the customer continues to purchase products or services from at least one of the billers after the service provider acquires ownership of the receivables associated with the account data received.
4. The method of claim 1, wherein the account charge is calculated by a computer application.
5. The method of claim 4, wherein the computer application comprises a financial institution application.
6. The method of claim 5, wherein the financial institution comprises a bank.

9. The method of claim 1, wherein one of the plurality of customer accounts comprises at least one selected from the group of a recurring bill account, a retail account, a communications account, and a financial account.
10. The method of claim 9, wherein the recurring bill account comprises at least one selected from the group of an electric account, a gas account, a cable account, a home security account, and a water account.
11. The method of claim 9, wherein the retail account comprises at least a credit card account.
12. The method of claim 9, wherein the communications account comprises at least one selected from the group of a long distance account, a local account, a wireless account, and an Internet access account.
13. The method of claim 9, wherein the financial account comprises at least one selected from the group of an insurance account, an investments account, an auto account, a bank statement account, an installment account, and a mortgage account.
14. The method of claim 9, wherein the cable services include pay television services.
15. The method of claim 1, further comprising automatically formatting the account charges.
16. The method of claim 15, further comprising transmitting the formatted account charges to a bill aggregator.
17. The method of claim 1, wherein the account data comprises usage data.



18. The method of claim 17, further comprising automatically calculating a usage charge from the usage data.

19. The method of claim 18, wherein the usage charge is calculated according to a predefined usage pricing schedule.

20. The method of claim 19, further comprising automatically calculating a tax associated with the usage charge.

21. The method of claim 20, wherein the tax is calculated according to a predefined usage charge tax schedule.

22. The method of claim 21, further comprising automatically calculating the account charge from the usage charge and the associated tax.

23. The method of claim 1, further comprising automatically validating the account data.

24. The method of claim 23, wherein validating comprises automatically comparing the account data with predefined account data parameters.

25. The method of claim 24, wherein validating further comprises automatically rejecting account data that falls outside the predefined account data parameters.

26. The method of claim 1, wherein aggregating further comprises automatically validating the account charges.

27. The method of claim 26, wherein validating further comprises automatically comparing the account charges with predefined account parameters.

28. The method of claim 27, wherein validating further comprises automatically rejecting account charges that fall outside the predefined account parameters.

29. The method of claim 1, wherein aggregating comprises automatically assembling the account charges.

30. The method of claim 29, wherein at least one of the account charges relates to a credit card account, and wherein assembling comprises automatically calculating at least one selected from the group of a fee and a finance charge associated with the credit card account charge.

31. The method of claim 30, wherein assembling further comprises automatically calculating a credit card account payment due amount from the credit card account charge and at least one selected from the group of the fee and the finance charge.

32. The method of claim 29, wherein assembling further comprises automatically calculating a discount associated with the assembled account charges.

33. The method of claim 32, wherein the discount is calculated according to a predefined discount schedule.

34. The method of claim 29, wherein assembling further comprises automatically calculating a rebate amount associated with the assembled account charges.

35. The method of claim 29, wherein assembling further comprises automatically calculating a reward amount associated with the assembled account charges.

36. The method of claim 1, further comprising automatically validating the aggregated account charges.

37. The method of claim 1, wherein the formatted bill comprises an electronic mail message.
38. The method of claim 1, wherein rendering comprises automatically storing the formatted bill for the customer in a storage location.
39. The method of claim 38, wherein the storage location comprises a server.
40. The method of claim 38, further comprising transmitting the formatted bill from the storage location to a terminal.
41. The method of claim 40, further comprising displaying the formatted bill at the terminal by the customer.
42. The method of claim 1, further comprising transmitting an inquiry for the customer regarding at least one of the customer accounts.
43. The method of claim 1, further comprising transmitting a request for the customer for an information change regarding at least one of the customer accounts.
44. The method of claim 1, further comprising transmitting an order for the customer for at least one of the customer accounts.
45. The method of claim 44, further comprising processing an order for the customer for the customer account.
46. The method of claim 1, further comprising transmitting a request for the customer for cancellation of at least one of the customer accounts.

47. The method of claim 1, further comprising transmitting a request for the customer for an adjustment of the combined bill regarding at least one of the customer accounts.

48. The method of claim 47, wherein the customer account comprises a recurring bill account.

49. The method of claim 1, further comprising the customer paying the bill.

50. A system for combined billing for at least one customer on a plurality of customer accounts, comprising:

means for receiving account data for the plurality of customer accounts electronically from time-to-time by a service provider from each of a plurality of billers;

means for acquiring ownership of receivables represented by the account data by the service provider under contractual arrangements with the plurality of billers upon receipt of the account data;

means for automatically calculating account charges for the plurality of customer accounts from the account data;

means for aggregating the account charges for a least one customer on the plurality of customer accounts;

means coupled to the aggregating means for automatically formatting a combined bill for the customer from the aggregated account charges; and

means associated with the formatting means for rendering the combined bill to the customer;

wherein at least one of the plurality of accounts is a recurring bill account and wherein the customer continues to purchase products or services from at least one of the billers after the service provider acquires ownership of the receivables associated with the account data received.

51. The system of claim 50, wherein the aggregating means comprises a server.

52. The system of claim 50, wherein the formatting means comprises a server.
53. The system of claim 50, wherein the rendering means comprises a server.
54. A method of combined billing for at least one customer on a plurality of customer accounts by a service provider, comprising:
- entering contractual arrangements with a plurality of billers to have their account data for the plurality of customer accounts delivered to a service provider electronically;
  - receiving the account data electronically from time-to-time during a billing cycle by the service provider from each of the billers, each reading out transactions one at a time to an accounts receivable computer system of the service provider;
  - storing the account data at a customer level in a computer database of the service provider;
  - acquiring ownership by the service provider of receivables represented by the account data under the contractual arrangement when the account data is received by the service provider;
  - remitting payment for the receivables to the billers by the service provider under the contractual arrangement within a pre-determined period after receiving the account data;
  - automatically calculating account charges for the plurality of customer accounts from the account data;
  - aggregating account charges for at least one customer on a plurality of customer accounts;
  - automatically generating a combined bill for the customer from the aggregated account charges at a pre-determined cycle time for the customer's account; and
  - automatically rendering the combined bill to the customer as a debt of the customer to the service provider as owner of the receivable represented by the combined bill;

wherein at least one of the plurality of accounts is a recurring bill account and wherein the customer continues to purchase products or services from at least one of the billers after the service provider acquires ownership of the receivables associated with the account data received.

55. A system of combined billing for at least one customer on a plurality of customer accounts by a service provider, comprising:

means for entering contractual arrangements with a plurality of billers to have their account data for the plurality of customer accounts delivered to a service provider electronically;

means for receiving the account data electronically from time-to-time during a billing cycle by the service provider from each of the billers, each reading out transactions one at a time to an accounts receivable computer system of the service provider;

means for storing the account data at a customer level in a computer database of the service provider;

means for acquiring ownership by the service provider of receivables represented by the account data under the contractual arrangement when the account data is received by the service provider;

means for remitting payment for the receivables to the billers by the service provider within a pre-determined period after receiving the account data;

means for automatically calculating account charges for the plurality of customer accounts from the account data;

means for aggregating account charges for at least one customer on a plurality of customer accounts;

means for automatically generating a combined bill for the customer at a pre-determined cycle time for the customer's account, ;

means for automatically formatting a combined bill for the customer from the aggregated account charges; and

means for automatically rendering the combined bill to the customer as a debt to the service provider as owner of the receivable represented by the combined bill;

wherein at least one of the plurality of accounts is a recurring bill account and wherein the customer continues to purchase products or services from at least one of the billers after the service provider acquires ownership of the receivables associated with the account data received.

56. A method of combined billing for at least one customer on a plurality of customer accounts by a financial institution, comprising:

- entering contractual arrangements with a plurality of billers to have their account data for the plurality of customer accounts delivered to a financial institution electronically;

- periodically receiving the account data electronically during a billing cycle by the financial institution from each of the billers, each reading out transactions one at a time to an accounts receivable computer system of the financial institution;

- storing the account data at a customer level in a computer database of the financial institution;

- acquiring ownership by the financial institution of receivables represented by the account data under the contractual arrangement when the account data is periodically received by the financial institution;

- remitting payment for the receivables to the billers by the financial institution under the contractual arrangement within a pre-determined period after receiving the account data;

- automatically calculating account charges for the plurality of customer accounts from the account data;

- aggregating account charges for at least one customer on a plurality of customer accounts;

- automatically generating a combined bill for the customer from the aggregated account charges at a pre-determined cycle time for the customer's account; and

- automatically rendering the combined bill to the customer as a debt of the customer to the service provider as owner of the receivable represented by the combined bill;

wherein at least one of the plurality of accounts is a recurring bill account and wherein the customer continues to purchase products or services from the at least one of the billers after the service provider acquires ownership of the receivables associated with the account data received.

57. A system of combined billing for at least one customer on a plurality of customer accounts by a service provider, comprising:

- means for entering contractual arrangements with a plurality of billers to have their account data for the plurality of customer accounts delivered to a service provider electronically;

- means for periodically receiving the account data electronically from time-to-time during a billing cycle by the service provider from each of the billers, each reading out transactions one at a time to an accounts receivable computer system of the service provider;

- means for storing the account data at a customer level in a computer database of the service provider;

- means for acquiring ownership by the service provider of receivables represented by the account data under the contractual arrangement when the account data is periodically received by the service provider;

- means for remitting payment for the receivables to the billers by the service provider within a pre-determined period after receiving the account data;

- means for automatically calculating account charges for the plurality of customer accounts from the account data;

- means for aggregating account charges for at least one customer on a plurality of customer accounts;

- means for automatically generating a combined bill for the customer at a pre-determined cycle time for the customer's account ;

- means for automatically formatting a combined bill for the customer from the aggregated account charges; and

- means for automatically rendering the combined bill to the customer as a debt to the service provider as owner of the receivable represented by the combined bill;



wherein at least one of the plurality of accounts is a recurring bill account and wherein the customer continues to purchase goods or services from the at least one of the billers after the service provider acquires ownership of the receivables associated with the account data received.

**(9) Evidence Appendix**

There is no evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131 and no other evidence entered by the examiner and relied on by appellant in the appeal.

**(10) Related Proceedings Appendix**

Attached is copy of the Decision on Appeal issued by the Board on September 23, 2004 in Appeal No. 2004-0094 refusing to sustain the Examiner's rejection of claims 1, 4-6, and 9-57 in a previous decision by the Examiner in this application as identified in Section (2) of this Appeal Brief.

Except as noted above, there are no other decisions rendered by a court or the Board in any other appeals or interferences related to this case.



EXPRESS MAIL NO. EV517995883US

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 28

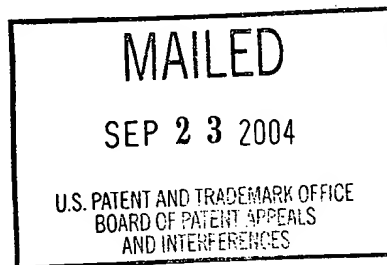
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte PATRICK SAVAGE, JITENDRA CHHIKARA and  
FREDERICK W. PLATZ, JR.

Appeal No. 2004-0094  
Application No. 09/181,658

ON BRIEF

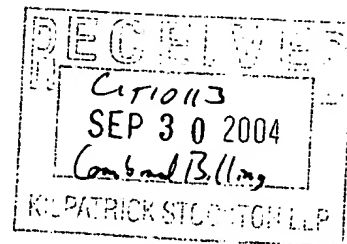


Before JERRY SMITH, FLEMING and NAPPI, Administrative Patent Judges.

NAPPI, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1, 4 through 6, 9 through 57.



### **The Invention**

The invention relates to a computerized system to combine the billings from multiple vendors into a single statement for a customer. (See appellants' specification page 3). The system is implemented by a financial institution, which through contracts with billers, has bill data electronically transmitted to the financial institution (see appellants' specification page 5). The financial institution obtains ownership of the receivables for each of the bills. The financial institution provides a bill to the customer for the services provided by the vendors working with the financial institution (see page 6 of appellants' specification).

Claim 1 is representative of the invention and is reproduced below.

1. A method of combined billing for at least one customer on a plurality of customer accounts, comprising:

receiving account data for the plurality of customer accounts electronically from time-to-time by a service provider from each of a plurality of billers;

acquiring ownership of receivables represented by the account data by the service provider under contractual arrangements with the plurality of billers upon receipt of the account data;

automatically calculating account charges for the plurality of customer accounts from the account data;

aggregating the account charges for at least one customer on the plurality of customer accounts;

automatically formatting a combined bill for the customer from the aggregated account charges; and

automatically rendering the combined bill to the customer;

wherein at least one of the plurality of accounts is a recurring bill account and wherein the customer continues to purchase products or services from at least one of the billers after the service provider acquires ownership of the receivables associated with the account data received.

### References

The references relied upon by the examiner are:

Smorodinsky	6,049,786	April 11, 2000 (filed July 22, 1997)
-------------	-----------	---

Saville "Convergent Billing & Customer Care", A Telecommunications Industry White Paper, Spring 1997, pp. 1-10.

### Rejections at Issue

Claims 1, 4, 9 through 16, 19 through 22, 32 through 35, 38 through 41 and 50<sup>1</sup> through 57 stand rejected under 35 U.S.C. § 103 as being obvious over Saville in view of Official Notice. Claims 5, 6, 17<sup>2</sup>, 18, 23 through 31, 36, 37, 41 through 49 stand rejected under 35 U.S.C. § 103 as being obvious over Saville in view of Official Notice and Smorodinsky. Rather than repeat the arguments of appellants or the examiner we

---

<sup>1</sup> It is noted that the statement of the rejection does not identify that claim 50 is included in the rejection under 35 U.S.C. § 103 as being obvious over Saville in view of Official Notice. However, the explanation of the rejection includes claim 50 and appellants in their arguments address claim 50 as included in the rejection under 35 U.S.C. § 103 as being obvious over Saville in view of Official Notice. Accordingly, we will treat claim 50 as being included in this rejection. See *Ex Parte Emm* 118 USPQ 180, 181 (BdPatApp&Int, 1958).

<sup>2</sup> It is noted that the statement of the rejection does not identify that claim 17 is included in the rejection under 35 U.S.C. § 103 as being obvious over Saville in view of Official Notice and Smorodinsky. However, for the same reasons provided *supra* with respect to claim 50, we will treat claim 17 as included in the rejection under 35 U.S.C. § 103 as being obvious over Saville in view of Official Notice and Smorodinsky.

make reference to the appeal brief<sup>3</sup> and the examiner's answer for the respective details thereof.

### Opinion

With full consideration being given to the subject matter on appeal the examiner's rejection and the arguments of the appellants and the examiner, for the reasons stated *infra* we will not sustain the examiner's rejection of claims 1, 4 through 6, 9 through 57 under 35 U.S.C. § 103.

We first consider the examiner's rejection of claims 1, 4, 9 through 16, 19 through 22, 32 through 35, 38 through 41 and 50 through 57. The examiner sets forth this rejection on pages 4 through 14 of the examiner's answer. The examiner states on pages 13 and 14 of the answer:

Saville does not explicitly disclose acquiring ownership of receivables represented by the account data by the service provider under contractual arrangements with the plurality of billers upon receipt of the account data. Official Notice is taken that it is old and well known within the financial services industry wherein a financial institution buys debts, such as bills, from other organizations. This is common in the mortgage market between the first and secondary markets. This is also used by companies who need cash and sell their account receivables (debts) to a financial institution or collection agency. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to acquire ownership of receivables. One would be motivated to acquire ownership of receivables in order to increase the flexibility of the financial solutions and to integrate all the steps of the billing process with the reception and control of the customer payments.

---

<sup>3</sup> This decision is based upon the appeal brief filed by appellants on April 4, 2003.

We note that in the amendment and arguments filed on July 26, 2001, appellants requested the examiner to provide evidence to support the reliance on official notice. The examiner has not provided the requested evidence in either the subsequent office action, dated January 15, 2001, or the Examiner's answer, rather the examiner reiterated the same reasoning, relying on Official Notice. Nonetheless, appellants have subsequently admitted some of the evidence officially noticed by the examiner by stating, on page 9 of the brief:

Appellant agrees that it is common in the mortgage market for mortgages to be sold between the first and secondary markets and that companies needing cash sometimes sell their account receivables (debts) to a financial institution or collection agency.

However, appellants argue, on page 9 of the brief, that the claimed invention is different than the scenario of selling mortgages and debit as:

Appellant's [sic] claims relate to acquiring ownership of receivables represented by account data that is electronically received from time-to-time from each of a plurality of billers, wherein at least one of the plurality of accounts is a recurring bill account, wherein a customer continues to purchase products or services from at least one of the billers after the service provider acquires ownership of the receivables associated with the account data received, and wherein the service provider acquires ownership of receivables associated with the subsequently purchased products or services after receiving account data for the customer account from the at least one biller.

Appellants further differentiate the claimed invention from the scenario of selling mortgages by arguing, on page 10 of the brief, that "the selling of a particular mortgage



between the first and secondary markets, as cited by the Examiner, is a one-time acquisition by the purchaser and is not recurring."

We find that appellants' arguments are not commensurate with the scope of the claims. We do not find that any of independent claims 1, 50, 54, 55, 56 or 57 include a limitation that "wherein the service provider acquires ownership of receivables associated with the subsequently purchased products or services after receiving account data for the customer account from the at least one biller" as argued by appellants on page 9 of the brief. Nonetheless, we do find that independent claims 1, 50, 54, 55, 56 or 57 include limitations directed to receiving account data electronically from time-to-time and acquiring ownership of the receivables associated with the account.

Appellants argue, on page 10 of the brief that there is no motivation or suggestion in the references to combine the officially noticed evidence with the teaching of Saville.

The examiner's response to appellants' arguments, on page 21 of the answer, reiterates the statement from the January 15, 2002 final rejection, that buying and selling debts is "old and well known." Further, the examiner states, on page 21 of the answer: "[e]xaminer notes that the [sic] Seville discloses by [sic] debits, and that action is not limited to a one-spot and not limitation shows that this step in Saville can be object of recurring actions."

We do not find the examiner's reasoning to be convincing or supported by evidence of record. While we concur with the examiner that Saville teaches a system where several business units can combine their bills for a single customer to one bill (see Saville, page 4, 4<sup>th</sup> paragraph and 7<sup>th</sup> paragraph), we find that the examiner has not shown that Saville teaches or contains a suggestion that ownership of the account receivables is acquired from the billers upon receipt of the account data. Further, we consider the examiner's statement, that buying debit is old and well known and that one would be motivated to "acquire ownership in order to increase the flexibility of the financial solutions" to be a broad conclusory statement which is un-supported by evidence of record.

Our reviewing court has "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and arguments." *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). "[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." *In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). When determining obviousness, "[t]he factual inquiry whether to combine references must be thorough and searching." *Lee*, 277 F.3d at 1343, 61 USPQ2d at 1433, *citing McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001). "It must be based on objective evidence of record." *Id.* "Broad

conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617.

"Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact." *Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617, *citing McElmurry v. Arkansas Power & Light Co.*, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993). The Federal Circuit states that, "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), citing *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In addition, our reviewing court stated in *Lee*, 277 F.3d at 1343, 61 USPQ2d at 1433, that when making an obviousness rejection based on combination, "there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by Applicant" (quoting *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998)).

Finally, in as much as appellants have admitted, on page 9 of the brief that "it is common in the mortgage market for mortgages to be sold between the primary and secondary markets and that companies needing cash sometimes sell their accounts receivables (debits) to a financial institution or collection agency", we do not find that appellants have admitted that the claimed features of: receiving account data

electronically from time-to-time, acquiring ownership of the receivables represented by the account data and wherein at least one of the accounts is a recurring bill, is well known. Further, the examiner has not shown, nor do we find, that appellants' admission provides any suggestion to modify Saville's system, where a several business units can combine their bills for a single customer to one bill, to include acquiring ownership of the receivables represented by the service provider. Accordingly, we will not sustain the rejection of claims 1, 4, 9 through 16, 35, 38 through 41 and 50 through 57.

We next consider the rejection of claims 5, 6, 17, 18, 23 through 31, 36, 37, 41 through 49 stand rejected under 35 U.S.C. § 103 as being obvious over Saville in view of Official Notice and Smorodinsky. Claims 5, 6, 17, 18, 23 through 31, 36, 37, 41 through 49 all ultimately depend upon independent claim 1 and accordingly contain the same limitations of claim 1. As discussed *supra* the combination of Saville and the officially noticed facts do not teach all of the limitations of claim 1. The examiner has not asserted, nor do we find that Smorodinsky teach or suggest a system where ownership of the account receivables is acquired from the billers upon receipt of the billers. Accordingly, we will not sustain the rejection of claims 5, 6, 17, 18, 23 through 31, 36, 37, 41 through 49.

Appeal No. 2004-0094  
Application No. 09/181,658

For the forgoing reasons, we will not sustain the examiner's rejections of claims 1, 4 through 6, 9 through 57 under 35 U.S.C. § 103.

Reversed

*Gerry Smith*  
JERRY SMITH

JERRY SMITH  
Administrative Patent Judge

  
MICHAEL R. FLEMING  
Administrative Patent Judge

# BOARD OF PATENT APPEALS AND INTERFERENCES

  
ROBERT NAPPI  
Administrative Patent Judge

RN/RWK

Appeal No. 2004-0094  
Application No. 09/181,658

KILPATRICK STOCKTON LLP  
607 14<sup>TH</sup> STREET N.W.  
SUITE 900  
WASHINGTON, DC 20005



## EXPRESS MAIL CERTIFICATE

"Express Mail" mailing label number: EV 517995883 US

Date of Deposit: October 30, 2006

Type of Document(s): Transmittal Form;  
Petition for Extension of Time  
Under 37 CFR 1.136(a) (in duplicate);  
Appeal Brief;  
Forms PTO-2038 for \$450 and \$500; and  
Return Postcard

Serial No.: 09/181,658

Date Filed: October 29, 1998

I hereby certify that the documents identified above are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. §1.10 on the date indicated above and are addressed to Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Catherine A. Johnson  
Catherine A. Johnson